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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,855	07/23/2001	Shoji Nakamura	04558/053001	3890

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ROSENTHAL & OSHA L.L.P.
1221 MCKINNEY AVENUE
SUITE 2800
HOUSTON, TX 77010

EXAMINER	
RHEE, JANE J	
ART UNIT	PAPER NUMBER
1772	9

DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS9

Office Action Summary	Application No.	Applicant(s)	
	09/911,855	NAKAMURA ET AL.	
	Examiner	Art Unit	
	Jane J Rhee	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-8 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-8 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1-4,6-8 are rejected under 35 U.S.C. 102(e) as being unpatentable by Sakai et al. (6383404).

Sakai et al. discloses a glass substrate for a magnetic disk comprising an upper and lower principal surfaces and outer surface joining the upper and lower principal surfaces (col. 15 lines 1-34), an inner surface joining the upper and lower principals surfaces, (col. 15 lines 1-34), the inner surface defining a through-hole in the a central portion of the substrate (col. 14 lines 57-67, col. 15 lines 1-34). Sakai et al. discloses that the average surface roughness is no greater than 0.5nm (col. 2 line29). Sakai et al. discloses that principal surfaces have a maximum height no greater than 5.0nm (col. 2

line 30-31). Sakai et al. discloses that the inner surface is ground and polished (col. 15 lines 8 and 22). Sakai et al. discloses that the glass substrate has a thickness of 0.3mm to 1.0mm and a diameter of 25.4mm to 88.9mm (col. 13 lines 42-43). Since Sakai et al. discloses the same surface roughness, maximum height, thickness and diameter it is inherent that the waviness is no greater then 0.5nm.

Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitations; wherein a mirror surface property of molding die is transcribed onto the upper and lower principal surfaces, and an outer diameter satisfies a desired dimensional tolerance by selecting a predetermined volume

of a glass material, wherein a thickness of the molded glass substrate satisfies a desired dimension and tolerance by adjusting a barrel die size, or limitations like molded, formed by molding between precision planar processing members, molding free face, ground, polished, and fire polished is a method of production and therefore does not determine the patentability of the product itself.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claim 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Sakai et al. in view of Watanabe et al. (6277465).

Sakai et al. discloses that the glass substrate has an average surface roughness that is no greater than 0.5nm (col. 2 line29) and that surfaces have a maximum height no greater than 5.0nm (col. 2 line 30-31). Sakai et al. fail to disclose that the principal surface has flatness no greater than 3μm. Watanabe et al. teaches that the average surface roughness is no greater than 0.5nm (col. 1 lines 31), the maximum height is no greater than 5.0nm (col. 1 lines 31-32), and that the principal surface has a flatness no greater than 1μm (col. 1 line23) for the purpose of achieving a high recording density for a surface of magnetic recording medium (col. 1 lines 11-12).

Therefore, it would have been obvious to one of ordinary skill in the art to provide Sakai et al. with a principal surface that has a flatness no greater than 1μm in order to

achieve a high recording density for a surface of magnetic recording medium taught by Watanabe et al. (col. 1 lines 11-12).

Response to Arguments

3. Applicant's arguments filed December 12,2002 have been fully considered but they are not persuasive.

In response to applicant's argument that Sakai et al. fail to disclose a small waviness no greater than 0.5nm and is not considered inherent, Sakai et al. discloses that the each of the principal surfaces has a maximum height Ry of no greater than 5nm (col. 5 lines 3-4), Sakai et al. also discloses that when the height distribution of the peaks is not exceeding 5, the roughness relatively becomes uniformed (col. 5 lines 4-5) therefore obtaining a small waviness. Since Sakai et al. discloses the same surface roughness, maximum height, thickness and diameter it is inherent that the waviness is no greater then 0.5nm.

In response to applicant's argument that Sakai et al. fail to disclose a molding free face, Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely

because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation molding free face is a method of production and therefore does not determine the patentability of the product itself.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane J Rhee whose telephone number is 703-605-4959. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jane Rhee
February 21, 2003

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

2/21/03